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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/923,071

08/06/2001

Michael J. Sullivan

174-956

1486

23517

7590

03/21/2003

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EXAMINER

GORDON, RAEANN

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

NK

Office Action Summary

Application No.

09/923,071

Applicant(s)

SULLIVAN, MICHAEL J.

Examiner

Raeann Gorden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 23-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 23-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 and 23-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimosaka et al (5,730,665) in view of Bandlish (4,847,319).

Regarding claims 1, 10, 11, 14, 23, and 30, Shimosaka discloses a golf ball comprising a core, an intermediate layer, and a cover. The intermediate layer is formed from single or plural layers of a laminate film. In regards to claims 2, 26, and 31, Shimosaka discloses the film may be made from polyurethane, silicone, or epoxy (col 3, lines 55-62). Regarding claims 12 and 13, the film has a thickness from 50 to 400 um or 0.05 to 0.4 mm (col 3, line 64). Regarding claims 24 and 25, process of curing and the hardness relative to different stages of the curing are method steps and not relevant to the final product. Regarding claims 3-8, 27-28, 32-33, Shimosaka does not disclose details regarding the composition of the film. Bandlish teaches a polyurethane coating composition comprising a blocked isocyanate, a ketone or aldehyde, and various additives and/or fillers. Regarding claim 9, Bandlish teaches a curing agent. One skilled in the art would have modified the invention of Shimosaka to improve the durability of the film.

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Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimosaka et al (5,730,665) in view of Bandlish (4,847,319) as applied to claims 1-14 above, and further in view of Shimosaka (5,749,796). Shimosaka '665 in view of Bandlish discloses the invention as shown above but does not disclose a wound intermediate layer. Shimosaka '796 teaches a golf ball comprising a resin film layer and a wound intermediate layer. One skilled in the art would have included a wound intermediate layer to achieve the properties such as spin, flying distance, and durability, which are common in wound golf balls.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimosaka et al (5,730,665) in view of Bandlish (4,847,319) as applied to claims 1-14 above, and further in view of Renard (6,068,561). Shimosaka '665 in view of Bandlish discloses the invention as shown above but does not disclose the film layer as part of the core or core shell. Renard teaches thin layers surrounding the core layer (Fig 5). One skilled in the art would have included the thin or film layers around the core to improve the durability of the core layer.

Response to Arguments

Applicant's arguments filed 1-2-03 have been fully considered but they are not persuasive. Applicant argues the prior art does not disclose a staged resin film (SRF). Applicant's invention appears to be focused on the method of making the SRF and not the structural features of the golf ball. The claims requiring the first hardness to be 10 to 80% of the second hardness do not limit the SRF since the comparison is based on the

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method of curing (claims 23 and 30). The claims should include structural features based on the final product and not comparisons between properties during different stages of curing. The later limitations are method steps and are not patentable distinctions that will overcome the prior art. As currently claimed the golf ball comprises a layer made from polyurethane, polyurea, epoxy, etc wherein the composition comprises a partially or totally blocked isocyanate an isocyanate compound etc, and additives/fillers.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

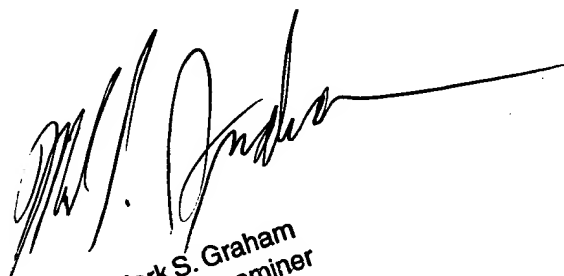
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on 7:30 AM to 5:00 PM Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

rg
March 20, 2003



Mark S. Graham
Primary Examiner